

Attorney Docket No. 000004

**REMARKS**

Claims 1-5, 9, 11-15, 18-22, 27-35, and 36-46 are presented for examination. Claims 1, 11, 18, 27, and 29 are currently amended. Claims 6-8, 10, 16-17, and 23-26 have previously been canceled. New claims 36-46 have been added.

In the Office Action mailed on Aug. 23, 2005, the Examiner rejected Claims 1, 11, 18, and 27 under 35 USC § 112, second paragraph. Claims 1-8, 10, 11, 13, 14, and 16-27 have been rejected under 35 USC 103(a) as being unpatentable over Foladare et al. ("Foladare") (US 5,978,671) in view of Landell et al. ("Landell") (US 4,994,983). Claims 9 and 15 have been rejected under 35 USC 103(a) as being unpatentable over Foladare in view of Landell and further in view of Brady (US 5,982,857). Claims 12 and 28 have been rejected under 35 USC 103(a) as being unpatentable over Foladare in view of Landell and further in view of Bambini et al. ("Bambini") (US 5,898,392).

**Rejections under 35 USC § 112**

Claims 1, 11, 18, and 27 have been rejected under 35 USC § 112, second paragraph, under the assertion that the phrase "recording quality of the corresponding voice tag is not high" is indefinite because it is unclear how high the recording quality is. The claims have been amended by replacing the "not high" recitation in order to address this issue. The amendment finds support in the specification at pages 12-13 with reference to description of Figure 3C and in claim 29 as filed.

Because satisfying a quality parameter (as in the amended claims) is objective and because examples are given in the specification as to how such a quality parameter may be determined, Applicants believe that the § 112 rejections to claims 1, 11, 18, and 27 should be withdrawn.

Foladare in view of Landell

Claims 1-8, 10, 11, 13, 14, and 16-27 have been rejected under 35 USC 103(a) as being unpatentable over Foladare in view of Landell. Because claims 6-8, 10, 16-17, and 23-26 have previously been canceled, Applicants assume that the rejection applies to claims 1-5, 11, 13, 14, 18-22, and 27. Furthermore, Applicants assume claims 29-35 to be included in this rejection, as appears in the Office action.

Claims 1, 18, and 29 have been amended, and new claims 36-46 have been added, support for which can be found in the specification as filed, for example, at pages 8-14 with reference to description of Figures 3B, 3C, and 3D and in Figures 3B, 3C, and 3D. In addition, new claims 42-46 find support throughout the specification as filed and, in particular with regard to the "feature" recited in claims 42-47, at page 5, last paragraph; page 6, first full paragraph; and at page 9 et seq. with reference to Figures 3B and 3D.

As previously noted, Foladare teaches a bridging and signaling unit having an associated database, rather than a "wireless communication device" as recited by Applicants' Claims 1, 18, 29, 36, 39, 42 and 45. In Foladare, a calling party places a call to a subscriber's personal telephone number, which is then routed to the bridging and signaling unit. The unit holds the call while a page is sent to the subscriber, whereupon the subscriber calls the bridging and signaling unit. The unit then bridges the calling party's call with the subscriber's call.

While Foladare may check for repeat callers and for whether the caller information is entered in the associated database, Foladare prompts the user directly in association with the use of that particular feature, e.g., saving caller information (col. 1, lines 60-65; col. 2, lines 26-39). Thus, Foladare's user is inherently assumed to be aware of the availability of such feature, e.g., saving caller information. Therefore, Foladare never discloses a specific check for

## Attorney Docket No. 000004

whether the user has ever used a feature (as opposed, for example, to checking whether the incoming caller is a first time caller or not) (col. 2, lines 49-57).

Thus, Foladare neither anticipates nor makes obvious "checking whether a first voice tag corresponding to any telephone number has already been saved," as recited in Claims 1 and 18 as amended and new claim 36; whether a voice tag "is a first voice tag to be saved," as in amended claim 29, whether a feature "has been previously utilized," as in new claim 42; nor providing different prompts, guidance, or options according to the result of the check, as in Claims 1, 18, and 29 as amended and new Claims 36 and 42.

Nor does Foladare check whether a user has ever used some particular first feature (e.g., any voice tag successfully saved) in order to provide a prompt to make the user aware of the availability to use a second feature (e.g., option to use voice dialing, as recited in amended claim 29 and new Claims 39 and 45).

Likewise, Landell is concerned with prompting a user in connection with training a voice recognition system, with the tacit assumption that the user is aware of the features of using the system but needs feedback from the system in order to keep the user coordinated with the system during its use (col. 7, line 54-cql. 8, line 13, lines 35-44). Landell also provides no disclosure or motivation for the checks and prompts related to whether a user has ever used a feature (as recited in Claims 1, 18, 36, and 42); rather, the checks and prompts disclosed by Landell are merely related to a particular feature that the user is already using.

Thus, both Foladare and Landell disclose an assumption that the user is familiar with the features being used and only provide the user with prompts for features in use. Thus, it is seen that neither Foladare, nor Landell, nor any of the other cited prior art, disclose checking for whether a feature has previously been used by the user of the wireless communication device as recited in amended Claims 1, 18, and 29 and new Claims 36-46.

In contrast to both Foladare and Landell, as well as the other prior art cited, the present claims (as amended in Claims 1 and 18, and new Claim 36 and supported at Figure 3B, step 328) check for whether a user has ever used a feature by checking for a voice tag corresponding to any telephone number (in contrast to just the telephone number currently in use) and provides prompts depending on the result of the check (i.e., according to the user's previous use of the features), as in Claims 1, 18, and 36.

In addition, and also in contrast to the cited prior art, the present Claims check for whether a user has previously used a first feature in order to provide a prompt to make the user aware of the availability to use a second feature as in Claims 29, 39, and 45 and supported at Figure 3D, step 348).

The present Claims is oriented and motivated toward solving a problem of making the user aware of an unused available feature, as in Claims 1, 18, 29, and 36-41, or of an unused feature related to a feature being used, as in new Claims 42-47 – Claims 1, 18, 29 and 36-41 being more specific to the particular features of voice tag saving and voice dialing. Foladare and Landell are oriented toward solving a problem of prompting the user in direct relation to the use of a feature of the system currently in use by the user. Thus, the present Claims is oriented and motivated toward solving a different problem than the problems to which Foladare and Landell are oriented. Hence the checks and prompts of the present Claims, as claimed by the amended claims, are used in a different method, for a different purpose, and under different conditions from those of Foladare, Landell, and the other cited prior art.

Therefore, Applicants submit that the references whether alone or in combination do not teach toward the present Claims.

Attorney Docket No. 000004

Therefore, Applicants submit that the § 103 rejections to the claims should be withdrawn and that the claims are now in condition for allowance.

### Conclusion

In light of the arguments and amendments presented herein, the Applicants respectfully submit that all pending claims are in condition for allowance. Accordingly, reconsideration and allowance of this Application is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

Dated: 2/16/06

By: Aec

Alex C. Chen  
Reg. No. 45,591  
Attorney for Applicants

QUALCOMM Incorporated  
Attn: Patent Department  
5775 Morehouse Drive  
San Diego, California 92121  
Telephone: (858) 651-5363  
Facsimile: (858) 658-2502